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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Tadahiro Ohmi

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

07/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Continuation Sheet

Continuation of 11. because: It remains the Examiner's position that the claims are unpatentable for reasons previously of record in the final office action.

Response to Applicant's Arguments

1. Applicant's arguments in the response filed June 19, 2008 regarding the 35 USC rejection over Carbo et al. (U.S. Patent No. 4,507,339) in view of Uchida et al. (U.S. Patent No. 4,248,676) of record have been carefully considered but are deemed unpersuasive.

Applicant argues that the combination fails to render obvious the claimed invention because it fails to teach that the surface roughness is a result effective variable with regard to the adherence of the coating. Applicant further argues that the office action has relied on impermissible hindsight based on the present specification, since Uchida does not disclose this concept.

Uchida does not explicitly teach the concept that the surface roughness effects the adherence of other coating. However, it is well known that surface roughness effects bonding strength. Therefore, the exact surface roughness of the metallic material is deemed to be a result effective variable with regard to the adherence of the coating. It would require routine experimentation to determine the optimum value of a result effective variable, such as surface roughness, in the absence of a showing of criticality in the claimed surface roughness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated by Uchida to have a surface

roughness of 0.8-3 gm in order to achieve a metallic matte surface. Applicant has not proved any evidence showing the criticality of the claimed surface roughness.

Applicant argues that the combination fails to render obvious the claimed invention because it fails to teach the filled pin hole feature. Applicant further argues the Carbo does not have pin holes and Uchida fills the crack of a chromium layer.

The examiner has already conceded that Carbo does not have pin holes and that Uchida is does not have the same claimed materials. However, since Uchida and Carbo are solving a similar problem it would have been obvious to one of ordinary skill in the art to have filled pin holes in Carbo in order to prevent crack formations.

Applicant argues that the combination fails to render obvious the claimed invention because it fails to teach the claimed process.

Method limitations do not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration.

Conclusion

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Alicia Chevalier/
Primary Examiner, Art Unit 1794
7/8/2008